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Masayuki Satake

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EXAMINER

HUANG, CHENG YUAN

ART UNIT

PAPER NUMBER

1787

NOTIFICATION DATE

DELIVERY MODE

04/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/532,712	Applicant(s) SATAKE ET AL.	
	Examiner CHENG HUANG	Art Unit 1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-9, and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Claim 1 recites “a first layer”, “a second layer”, “a third layer”, “an outer edge of the second layer”, and “an outer side edge of the first layer” that do not appear to have support in the originally filed specification.

4. Claim 1 recites “second layer and the third layer are laminated without a gap therebetween”. The cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

5. Claim 17 recites “a fourth layer” that does not appear to have support in the originally filed specification.

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6. Claim 18 recites “the second layer further including a second adhesive layer” that does not appear to have support in the originally filed specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 3-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites "an outer side edge of the second layer" in the last line of the claim which is confusing because it is not clear how the first recited outer side edge of the second layer could be located on the inside of itself. For the purpose of examination, the last line of the claim is considered to recite “an outer side edge of the third layer”.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1, 3-4, 9, and 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).

12. Regarding claim 1, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) comprising a first layer including a first optical film

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provided (protection plate 423, paragraph [0077]), a second layer (adhesives 424 and 425, paragraphs [0081] and [0086]) including a first adhesive layer (silicone adhesive 424, paragraph [0081]), and a third layer of a second optical film (base plate 421, paragraph [0079]), wherein the second layer inherently has a first surface and a second surface opposite to the first surface (Fig. 3) wherein the first layer is adhered to the first surface of the second layer and the third layer is adhered to the second surface of the second layer so that the first layer, the second layer and the third layer are laminated without a gap therebetween (Fig. 3 - see far right portion of the device), wherein at least a portion of an outer side edge of the second layer is located on the inside of an outer side edge of the first layer and located on the inside of an outer side edge of the second layer of a second (Figs 3 and 7).

13. Regarding claim 3, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein the portion of the outer side edge of the second layer extends to the vicinity of the outer side edge of the first layer in cross section (Figs 3 and 7).

14. Regarding claim 4, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein a cross section of the outer side edge of the second layer has a concave shape (silicone adhesive 424, Fig. 7).

15. Regarding claim 9, Miyazawa teaches an image display device (liquid crystal panels, paragraph [0135]) comprising the adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]).

16. Regarding claim 18, Miyazawa teaches wherein the second layer (adhesives 424 and 425, paragraphs [0081] and [0086]) further including a second adhesive layer (spacer 425, paragraph

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[0086]) on the first adhesive layer, and wherein the first adhesive layer has the first surface to which the first layer is adhered and the second adhesive layer has the second surface to which the third layer is adhered.

17. The recitation “laminated” is a process claim. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

18. Therefore, absent evidence of criticality regarding the presently claimed process and given that Miyazawa meets the requirements of the claimed adhesive optical film, Miyazawa clearly meets the requirements of present claims.

19. Regarding claim 19, Miyazawa teaches wherein the first optical film (protection plate 423, paragraph [0077]) is a protective film.

20. Regarding claim 20, Miyazawa teaches wherein the second optical film (base plate 421, paragraph [0079]) is a protective film.

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Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).

24. Miyazawa et al. is relied upon as disclosed above.

25. Regarding claims 4-8, the claimed limitations are regarded as changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04 (IV).

26. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the shape and amount of adhesive in the adhesive optical film of Miyazawa to control the strength or tightness of adhesion and internal sealability (paragraph [0110]).

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27. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atagi (JP2000214324A) in view of Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).

28. Regarding claim 1, Atagi teaches an adhesive optical film (optical film 3, paragraph [0007]) comprising a first layer including a first optical film (optical film 1 or phase difference film 24, paragraphs [0012] and [0025]), a second layer including a first adhesive layer (adhesive layer 2 or pressure sensitive adhesive 23, paragraphs [0012] and [0025]), a third layer of a second optical film (TAC films 21 or 22, paragraphs [0009] and [0025]) wherein the second layer inherently has a first surface and a second surface opposite to the first surface (Figs. 1 and 6) wherein the first layer is adhered to the first surface of the second layer and the third layer is adhered to the second surface of the second layer so that the first layer, the second layer and the third layer are laminated without a gap therebetween (Fig. 6), and wherein at least a portion of an outer side edge of the second layer is located on the inside of an outer side edge of the third layer (pressure sensitive adhesive 23 and TAC film 22, Fig. 6).

29. Atagi fails to teach wherein at least a portion of an outer side edge of the second layer is located on the inside of an outer side edge of the first layer.

30. However, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) comprising a second layer (silicone adhesive 424, paragraph [0081]) wherein at least a portion of an outer side edge of the second layer is located on the inside of an outer side edge of a first layer (protection plate, paragraph [0077]) and located on the inside of an outer side edge of a third layer (base plate 421, paragraph [0079], Figs 3 and 7).

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31. It would have been obvious to one of ordinary skill in the art at the time of the invention to include at least a portion of an outer side edge of the second layer of Miyazawa located on the inside of an outer side edge of a first layer and located on the inside of an outer side edge of a third layer for increased adhesion area and tight adhesion (Miyazawa, paragraph [0110]).

32. Regarding claim 2, Atagi teaches an adhesive optical film (optical film 3, paragraph [0016]) further comprising a second adhesive layer (pressure sensitive adhesive layer 23, paragraph [0025]) (Fig. 6).

33. Regarding claim 3, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein a portion of the inside edge in cross section (edge of adhesive 2, paragraph [0007]) extends to the vicinity of the edge line of the first optical film (edge of phase difference film 24, paragraph [0025]) (Fig. 6).

34. Regarding claims 4 and 5, Atagi fails to disclose an adhesive-type optical film (optical film 3) having the claimed convex and concave shapes of the inside edge of the adhesive.

35. However, regarding claim 4, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein the inside edge has a concave edge (silicone adhesive 424, Fig. 7).

36. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the shape of adhesive in the adhesive optical film of Miyazawa to control the strength or tightness of adhesion and internal sealability (paragraph [0110]).

37. Furthermore, the claimed limitations are regarded as changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent

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unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04 (IV).

38. Regarding claim 6, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein the field of the first optical film projected from the adhesive layer's end face may be along the entire perimeter of the first film (paragraphs [0013]-[0016]) which corresponds to the inside edge being formed on at least one-half of the total perimeter of the adhesive layer.

39. Regarding claim 7, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein the inside edge is formed on the whole of the edge line of the first adhesive layer (Fig. 6).

40. Regarding claim 8, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein a distance between the inside edge and the edge line of the first optical film is at most about 150 μm (paragraph [0013]) which overlaps the claimed range of 10 to 300 μm .

41. Regarding claim 9, Atagi teaches an image display device (liquid crystal display) comprising the adhesive optical film (optical film 3, paragraph [0012]) (paragraph [0002]).

42. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287) in view of Atagi (JP2000214324A).

43. Miyazawa et al. is relied upon as disclosed above.

44. Miyazawa et al. fails to teach a fourth layer on a first surface of the first layer.

45. However, Atagi teaches an adhesive optical film (optical film 3, paragraph [0007]) comprising first layer (optical film 1 or phase difference film 24, paragraphs [0012] and [0025]) intrinsically having a first surface and a second surface opposite to the first surface, and second

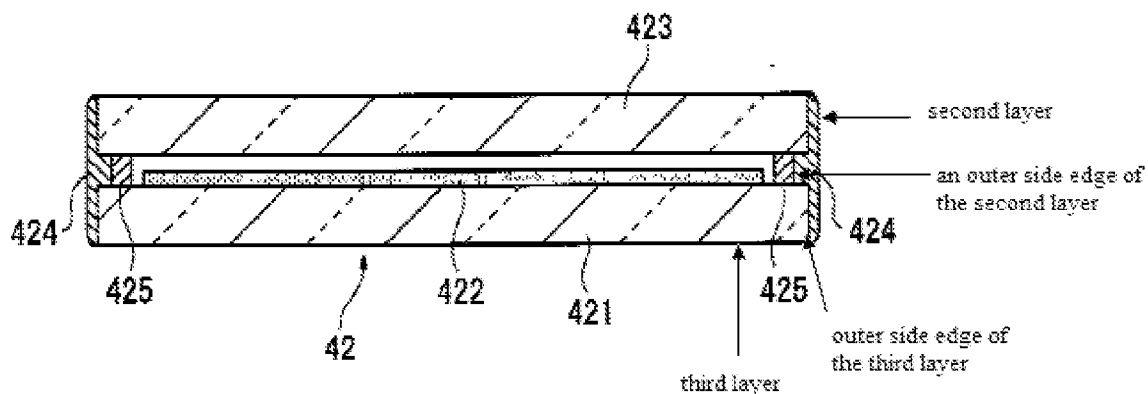
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layer including a first adhesive film (adhesive layer 2 or pressure sensitive adhesive 23, paragraphs [0012] and [0025]), and a fourth layer including a second adhesive layer (adhesive layer 2 or pressure sensitive adhesive 23, paragraphs [0012] and [0025]), wherein the fourth layer is adhered to the first surface of the first layer and the second layer is adhered the second surface of the first layer (See Fig. 6).

46. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a fourth layer including a second adhesive layer on the first surface of the first layer of Miyazawa for adhering the adhesive optical film to a surface such as a film in a liquid crystal display (paragraphs [0002] and [0005], Fig. 6).

47. The recitation “laminated” is a process claim. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

48. Therefore, absent evidence of criticality regarding the presently claimed process and given that Atagi meets the requirements of the claimed adhesive optical film, Atagi clearly meets the requirements of present claims.



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53. Applicants argue that regarding the request for a declaration or affidavit to show the difference between the punching edge type of Atagi and the adhesive inside edge of the presently claimed invention, “since Atagi is a patent publication and Applicants' specification is a sworn document, there is no logical basis for requesting the information, which has already be sworn to, be presented in declaration or affidavit.”

54. It is agreed that Applicants' specification and provided information are sworn documents. However, it is the Examiner's position that a declaration is needed to provide evidence that the punching edge type of Atagi is not equivalent to the presently claimed adhesive inside edge as argued by applicants.

Conclusion

55. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

56. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

April 16, 2010

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787